

Amendments to the Drawings:

The attached one (1) new sheet of drawings includes new FIG. 11. FIG. 11 shows the covering device shown in Fig. 1 but in FIG. 11 additional elements of this covering device are labeled. In FIG. 11, the first contact surface 35 of the underside, the second contact surface 30 of the underside, the groove section 34 of the underside, the first side 32 of the profiled cover, and the second side 31 of the profiled cover are all labeled.

Attached: One (1) New sheet of drawings

REMARKS/ARGUMENTS

The claims are 2-6, 10 and 12, with claims 8 and 11 having been withdrawn from consideration by the Examiner as being directed to a non-elected invention. A new FIG. 11 has been added to the drawings of the application. The specification has been amended to describe the new FIG. 11.

Reconsideration is expressly requested.

Claims 10 and 12 were rejected in the Final Office Action under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement with respect to the features a. - e. set forth on page 3 of the Office Action. In particular, the Examiner has taken the position that the following items are not supported by the disclosure: (a) a first contact surface; (b) a second contact surface; (c) a groove section; (d) the first contact surface extending past the clamping web; and (e) the second contact surface extending past the clamping web.

In the Response to Final Office Action dated November 22, 2010, Applicant provided an annotated FIG. 1 of the original drawings which explicitly labeled each of the items (a) - (e) mentioned above, and described how these features of Applicant's

claims are clearly in the embodiment of the profiled cover shown in the original drawings of the application.

In response in the Advisory Action dated December 13, 2010, the Examiner thanked Applicant for providing the annotated figure and explanation in response to the 35 U.S.C. § 112, first paragraph, written description requirement rejection, and the Examiner stated that he "would prefer this to be in an Amendment to the Drawings and Specification."

Attorney for Applicant called the Examiner on December 16, 2010 to inquire whether the rejection under the 35 U.S.C. § 112, first paragraph, written description requirement had been overcome. The Examiner indicated in that December 16, 2010 phone call that the 35 U.S.C. § 112, first paragraph, written description requirement rejection had not been overcome and that he is requiring the annotated drawing and explanation of the Response to Final Office Action to be submitted as an Amendment to the Drawings and as an Amendment to the Specification in order to overcome this rejection.

Accordingly, Applicant has submitted herewith a new FIG. 11 in which the features of Applicant's claims 10 and 12 that were denoted by the Examiner as a. - e. are labeled, and Applicant has

submitted herewith Amendments to the Specification to correspond to new FIG. 11 and the newly-labeled features of FIG. 11. Although these features are newly-labeled in FIG. 11, these same features are clearly visible in FIG. 1 which is part of the original drawings and which therefore provides support for these features recited in Applicant's claims 10 and 12.

Accordingly, Applicant respectfully submits that the rejections of claims 10 and 12 under the 35 U.S.C. § 112, first paragraph, written description requirement have been overcome and Applicant respectfully requests that these rejections be withdrawn.

In the Final Office Action, the Examiner took the position that claim 11, which was newly-submitted in the Amendment immediately prior to the Final Office Action, and amended claim 8 as presented in that Amendment (filed on July 8, 2010) are directed to an invention that is independent or distinct from the invention originally claimed because the previously examined claims were for the device of a profiled cover and the newly submitted invention is for the method of producing the floor covering device. In the Examiner's view, since the Applicant has already received an action on the merits for the originally

presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Applicant respectfully disagrees with the Examiner's position. In particular, contrary to the Examiner's assertion, Applicant's claims as originally filed included both claims directed to the device and claims directed to the method of producing a profiled cover. Moreover, the Examiner has already issued numerous Office Actions examining both types of claims, which indicates that there is no undue burden on the Examiner to review both the method claims and the device claims for simultaneous prosecution.

In view of the foregoing, Applicant respectfully requests that the restriction be withdrawn and that claims 8 and 11 be re-joined and examined on the merits.

The Examiner indicated in the Final Office Action that claims 5 and 6 contain allowable subject matter; however, the remaining claims were rejected on the basis of the prior art. Specifically, claims 10 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Stanchfield U.S. Patent No. 6,860,074*. The remaining rejected claims were rejected under 35

U.S.C. § 103(a) as being unpatentable over *Stanchfield* in view of *Neuhofer U.S. Design Patent No. D 542,941* (claims 2-3) and over *Stanchfield* and *Neuhofer U.S. Design Patent No. D 542,941* and further in view of *Kemper U.S. Patent No. 6,345,480* (claim 4).

The Examiner repeated his position with respect to these claims in the Advisory Action that although *Stanchfield* fails to disclose either of the floor covering devices that are recited in Applicant's claims 10 and 12, these floor covering devices would have been obvious to one of ordinary skill in the art because this worker skilled in the art could have performed a mere reversal of the essential working parts of the device of *Stanchfield* to make the floor covering devices recited in Applicant's claims 10 and 12.

Applicant again respectfully traverses these rejections in view of the following remarks.

It is respectfully submitted that the decision of *In re Einstein* 46 F.2d 373, 8 U.S.P.Q. 166 (1931) does not set forth the proposition that any disclosure by the prior art of the working parts of a device in any different arrangement whatsoever renders obvious all subsequent devices that include those

elements. Rather *In re Einstein* 46 F.2d 373, 8 U.S.P.Q. 166, 167 (1931) explicitly states that in order for a new arrangement of known elements to be patentable, "There must be some new device or some new and useful purpose accomplished." *In re Einstein* at 167. It is respectfully submitted that Applicant's profiled covers as recited in claims 10 and 12 provide a new device that achieve a new and useful purpose that is not achieved by the device of *Stanchfield*, and accomplished." *In re Einstein* at 167.

Hence, it is respectfully submitted that "the mere reversal of working parts" teaching of *In re Einstein* is inapplicable to Applicant's profiled covers as recited in claims 10 and 12.

Specifically, Applicant's floor covering device as recited in claims 10 and 12 allows the profiled cover to be supported flat over either of a compensating strip having a tongue and an elevated floor covering segment having a substantially completely flat top surface.

In contrast, *Stanchfield* fails to disclose a profiled cover having first and second contact surfaces on an underside of the profiled cover and on both sides of the clamping web that allow flat support of the profiled cover on floor coverings with substantially completely flat top surfaces. The molding device

11 of *Stanchfield* would not be able to be installed on each side of foot 16 on a floor covering with a substantially completely flat top surface, because the tab 18 would interfere so that most of arm 12 of the molding 11 would be elevated above the substantially completely flat top surface and only the tab 18 would lie flat on the substantially completely flat top surface. The narrow tab 18 would thereby support the entire weight of the arm or covering flange which could cause the narrow tab 18 to prematurely be broken off the arm or covering flange.

Moreover, neither of *Neuhofer, Jr. U.S. D542,942* and *Kemper et al. U.S. Patent No. 6,345,480* remedy the deficiencies of *Stanchfield* with respect to Applicant's claims 10 or 12, because neither of *Neuhofer, Jr.* and *Kemper et al.* discloses a tongue-and-groove joint as recited in Applicant's claim 10 and neither provides the benefits provided by Applicant's floor covering device as recited in claims 10 and 12. Each of *Neuhofer, Jr.* and *Kemper et al.* fails to disclose any tongue or groove on either of the profiled cover and the compensating strip that interacts with the other of the profiled cover and the compensating strip.

Because "the mere reversal of working parts" teaching of *In re Einstein*, which teaching is essential to the Examiner's prior art rejection of Applicant's claims 10 and 12, is inapplicable to

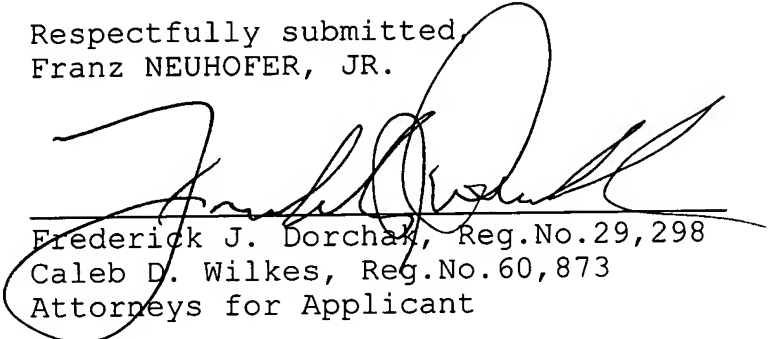
Applicant's profiled covers as recited in claims 10 and 12, it is respectfully submitted that Applicant's profiled covers as recited in claims 10 and 12 are patentable over *Stanchfield*.

Accordingly, it is respectfully submitted that Applicant's claim 10, together with claims 2-6 which depend thereon, and claim 12 are patentable over the prior art references cited by the Examiner.

In summary, new FIG. 11 has been added to the drawings and the specification has been amended. In view of the foregoing, it is respectfully requested that the claims be allowed and that this case be passed to issue.

Respectfully submitted,
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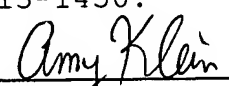
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Enclosures:

Appendix with one (1) new sheet of drawings

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, on the date indicated above, and is addressed to Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Amy Klein

APPENDIX